

### **Remarks**

The Applicant would like to thank the Office for the careful consideration given the present application in the initial Detailed Action on the merits of the claims. With the foregoing amendments and the ensuing remarks, the Applicant has endeavored to respond most properly to each of the points raised by the Office to ensure that the specification and claims now presented are allowable in all respects. With this in mind, the Applicant respectfully requests that the Office review and allow the current specification and claims.

In brief summary, the present application was filed with 68 claims in total with claims 1, 41, and 57 standing independently. With the current amendment, claims 1, 8, 11, 17, 39, and 41 through 68 have been canceled thereby leaving claims 2-7, 9, 10, 12-16, 18-38, and 40 pending for consideration. Claims 10, 15, 18, 20, 21, 23, 26, and 40 have been amended to stand independently.

### **Drawings**

With respect to the drawings, the Office noted FIGS. 8 and 10 specifically and required that Applicant show directional diagram flow for all connections. In reply, the Applicant has prepared and submitted herewith replacement sheets showing the required directional diagram flow for all connections. Each sheet includes "Replacement Sheet" in the header along with the required application identifying information referenced in 37 CFR 1.84. No new matter has been added.

Based on the foregoing, the Applicant submits that the Office's objections to the drawings have been met. Accordingly, the Office's reconsideration and allowance of the

application in this respect are respectfully requested.

**Claim Objections 37 C.F.R. 1.75(c)**

The Office objected to claims 34 and 61 under 37 C.F.R. 1.75(c), as being in improper dependent form for failing to further limit the subject matter of a previous claim. In reply, the Applicant has amended claim 34 to depend from claim 33, as properly noted by the examiner. Claim 61 has been canceled.

Based on the foregoing, the Applicant submits that the Office's objections to the claims have been met. Accordingly, the Office's reconsideration and allowance of the application in this respect are respectfully requested.

**Claim Rejections 35 U.S.C. § 112**

The Office rejected claim 11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the office indicated that the Applicant included a broad recitation in claim 10 and then expanded the inclusion in claim 11.

In reply, the Applicant submits that the decorative elements limitation set forth in original claim 11 was in fact a further limitation of claim 10. Claim 11 specifies decorative elements in addition to the structural elements, auto parts, makeup, and the like of claim 10. Nonetheless, Applicant has cancelled claim 11 and incorporated its "decorative elements" limitation into claim 10 thereby making still clearer that the decorative elements are a further category of reference images. With this, the Applicant respectfully submits all claims comply with 35 U.S.C. § 112 in all respects. Accordingly, their reconsideration and allowance are respectfully requested.

**Claim Rejections Under 35 USC §§ 102, 103**

With respect to the patentability of the claims, the Office preliminarily rejected claims 1, 2 and 4 as being anticipated by U.S. Patent No. 6,901,164 to Sheffer. Claims 1, 8, 9, 13-28, 31-38, 41-44, 46-54, and 57-66 were rejected as being anticipated by U.S. Patent No. 6,343,264 to Fenton et al, hereinafter Fenton. Claims 10-12 and 45 were rejected as anticipated by or, in the alternative, as being obvious under 35 U.S.C § 103 over Fenton. Claim 3 was rejected as being unpatentable under 35 U.S.C § 103 over Sheffer, as applied to claim 2 above, and further in view of U.S. Patent No. 6,459,825 to Lippincott. Claims 5 and 6 were rejected under 35 U.S.C § 103 as being unpatentable over Sheffer as applied to claim 2 above, and further in view of U.S. Patent No. 5,977,987 to Duluk, Jr. Claim 7 was rejected under 35 U.S.C § 103 as being unpatentable over Sheffer as applied to claim 2 above, and further in view of U.S. Patent No. 5,021,705 to Yamamoto et al.

Furthermore, Claims 29 and 30 were rejected under 35 U.S.C § 103 as being unpatentable over Sheffer as applied to claim 2 above, and further in view of U.S Patent Application No. 2002/0050518. Claims 39, 55, and 67 were rejected under 35 U.S.C § 103 as being unpatentable over Sheffer as applied to claim 2 above, and further in view of U.S. Patent No. 6,574,616 to Saghir. Finally, claims 40, 56, and 68 were rejected under 35 U.S.C § 103 as being unpatentable over Sheffer as applied to claim 2 above, further in view of Saghir, and further in view of U.S. Patent No. 4,536,848 to d'Entremont.

It is, of course, well settled that a proper anticipation rejection demands that the cited prior art reference identically disclose the claimed invention. As the Federal Circuit wrote

recently, “[f]or a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); See also, *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996).

It is equally clear that a proper obviousness analysis requires that one consider the entire claim as a whole and one must compare the claimed invention to the disclosures of the prior art. When references are sought to be combined or modified, “[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination [or modification]. The knowledge cannot come from the applicant's invention itself.” *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). For each modification or combination, there must be a reasonable expectation of success and the prior art reference or references must teach or suggest *all* of the claim limitations. See, e.g., MPEP § 706.02(j); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present case, the Applicant submits that each independent claim patentably defines over the prior art, particularly as those claims have been amended herein. Applicant further submits that each dependent claim is allowable in that it depends from an allowable base claim and in that each adds further patentable limitation thereto.

Considering in particular claim 10, which has been rewritten to stand independently, the Applicant respectfully submits that an anticipation rejection based on Fenton is improper. Fenton does not identically disclose the claimed invention as a proper anticipation rejection demands. Fenton references only color coding “every carpet in the entire product line.” Col. 5, lines 43-44. Fenton would not teach one skilled in the art to provide reference images that

include “structural elements, auto parts, makeup, body elements, hairstyles, flooring, ceiling elements, wardrobe elements, decorative elements and jewelry elements” as amended claim 10 expressly requires. The Office’s proposed reading of Fenton would be improper in that it would add disclosure to Fenton that simply does not exist. For this and further reasons, the Applicant submits that amended claim 10 is patentable over Fenton, and its reconsideration and allowance are respectfully requested.

Claim 2, which now depends from claim 10, is patentable even beyond its base claim in that it specifies that the image procuring device comprises a digital camera. Claims 3 and 4 enjoy added patentability for their respective requirements that the image procuring device comprise a still camera and then a motion camera. Regarding claim 4, as will be discussed further below, one will note that the camera in Fenton, a ‘Kodak DC120’, is not a “motion camera” as is required by claim 4. The user’s manual makes clear that the camera (<http://www.kodak.com/global/plugins/acrobat/en/service/digCam/dc120/manual/dc120english.pdf>) is merely a still camera.

Even further, claim 5 requires that the motion camera comprises a means for providing moving images in three-dimensions while claim 6 specifies that the means for providing moving images does so in virtual reality. Additionally, claim 7 further limits base claim 10 with the additional requirement that the requirement that the display device comprise an an ultra-high definition display screen thereby enhancing the in situ display of images under the invention. Claim 9 additionally requires that the reference images include reference colors.

Still further, claim 12, defines decorative elements to include furniture, shrubbery, wallpaper, rugs, curtains, blinds, window shades, and trim, which are nowhere found in any cited

reference as would be required for a proper anticipation rejection. Claim 13 adds patentable limitation by adding a means for suggesting and automatically coordinating one or more reference images based on a user-selected parameter. Particularly when one bears in mind the reference images set forth in claim 10, Fenton cannot fairly be said to teach or suggest such a limitation. Also, claim 14 specifies that the user-selected parameter comprises an input image.

Particularly as amended, claim 15 is not taught or suggested by Fenton. Amended claim 15 requires a user-selected parameter in the form of a design goal *comprising a structural style or a mood effect*. With its mere disclosure of the coding of colors, Fenton entirely fails to teach Applicant's claimed system where a user can input design goals, particularly as the phrase is defined in Applicant's specification and in claim 15. Claim 16 accentuates the unique invention claimed in claim 15 by requiring that the design goal input by a user includes desired furniture styles and decorating styles.

Claims 18 and 24, particularly as amended, are not anticipated or rendered obvious since Fenton does not disclose or even suggest unified *size* scaling as claims 18 and 24 demand. Fenton merely references a "universal color code", which cannot fairly be said to teach unified size scaling as is set forth in amended claims 18 and 24. Claims 19 and 25 are patentable even beyond claims 18 and 24 respectively since they additionally require the automatic adaptation of input images and reference images to a unified, substantially identical size scale, which is nowhere taught or suggested by the cited prior art.

Claim 20 has been amended to define even more clearly over the cited art. More particularly, amended claim 20 specifies that the system includes a means for providing a cost estimate to a user regarding the cost of a potential alteration, redecoration, addition, or

construction. Fenton has no equivalent disclosure such that a proper anticipation rejection is prevented. At most, Fenton merely discloses detecting and addressing inventory needs. It has no reference or suggestion of estimating the cost of a given project of the like. There is no teaching or suggestion of Applicant's claimed cost estimation capabilities. Accordingly, the Office's reconsideration and allowance of claim 20 are requested.

Claim 21 has also been amended to define most clearly over the prior art. As amended, claim 21 specifies that the system includes a means for providing "a time estimation as to the time required for a potential alteration, redecoration, addition, or construction... ." Nothing in Fenton teaches or suggests such a limitation. Fenton's identifying trends and adjusting strategies cannot fairly be said to disclose the claimed invention. Therefore, the Applicant respectfully requests the Office's reconsideration and allowance of claim 21 and each claim that depends therefrom. Claim 22 enjoys added patentable limitation since it adds the cost estimation abilities of claim 20 to claim 21.

Contrary to the Office's indication, Fenton does not disclose the system of claim 23. As noted above, the 'Kodak DC120' camera referenced in Fenton is not a "motion camera" as is required by claim 23. One can have reference to the user's manual for the camera (<http://www.kodak.com/global/plugins/acrobat/en/service/digCam/dc120/manual/dc120english.pdf>) where it is made clear that it is merely a still camera.

Furthermore, claim 23 requires a means for enabling a selective manipulation of the location and orientation of already procured images on the display device. Merely disclosing a still camera that itself can be moved about does not represent a corresponding teaching in Fenton. Nowhere does Fenton even contemplate the manipulation of the location and orientation

of procured images *on the display device* as claim 23 specifies. As a result, claim 23 cannot properly be said to be anticipated by Fenton.

Fenton fails to disclose the invention of amended claim 26. Fenton merely discloses light sources (i.e., incandescent fixtures, a skylight, and/or full-spectrum fluorescent lights) that are explicitly *external* to any display device. On the contrary, amended claim 26 requires a means for providing “a *display of simulated* light sources *on the display device* to bath the displayed image in a source of light.” Stated alternatively, the claimed light sources are simulated on the display device and are not external to the display device as taught by Fenton.

The ability to display simulated light sources on the display device is particularly relevant to Applicant’s goal of providing a truly realistic *in situ* display of images. The claimed light source display enables a user to view, for example, his or her own rooms bathed in light just as they would be in actuality while Fenton merely teaches providing ambient light in a room where a display screen is situated. The two systems are fundamentally different in structure, theory, and result. Consequently, amended claim 26 is patentable over Fenton, and its reconsideration and allowance is respectfully requested.

Each of claims 27 through 37 are patentable not only because they depend from allowable claim 26 but also because each adds patentable limitation thereto.

Claims 27 and 32, for example, additionally require a means for controlling the light source simulated on the display device. Since Fenton fails to teach displaying simulated light sources on the display device, it is still more clear that Fenton does not disclose controlling the type of light source.



Claims 28 and 33 enjoy added patentability since they specify “incandescent light, fluorescent light, full spectrum light, and natural sunlight” as the simulated light sources thereby even further differentiating from Fenton.

Likewise, claims 29 and 34 and then claims 30 and 35 claim first the ability to select a mixed light situation and then to adjust the relative intensity of displayed light sources. Each claim limitation is still more clearly not disclosed or even suggested in Fenton.

Still more uniquely, claims 31 and 36 claim means for controlling a location and orientation of the simulated light source. Nothing in Fenton or any other cited disclosure can reasonably be said to teach or suggest the claimed means.

Yet further, claim 37 requires that the means for providing simulated light sources enable a user to opt to display light as emanating from a shielded structure, which is even more clearly not found in Fenton.

Finally, amended Claim 40, which requires the display of display images for progressively increased display times through multiple display rounds, is not taught by even the combined prior art of Fenton, Saghir, and d'Entremont et al. The referenced portion of d'Entremont et al. merely describes the determination of “the time during which the selected photosensitive material must be exposed to light emitting from [a] display means to record image information... .” Col. 10, lines 12-16. Since it merely describes exposing photosensitive material to light *from* a display means, d'Entremont et al. has no bearing on Applicant's claimed display of images *on* a display screen for viewing by a user. Therefore, Applicant most respectfully submits that Claim 40 is patentable beyond the cited art, and its reconsideration and allowance are respectfully requested.

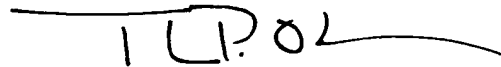
### **Conclusion**

Because no cited reference identically discloses the claimed invention and because there is no suggestion in the art to modify or combine any of the prior art references to approximate the claimed invention, the Applicant most respectfully submits that the claims now presented are patentable over the cited art. With this in mind, the Office's reconsideration and allowance of the specification and claims are respectfully requested.

The Applicant believes that all issues raised in the Detailed Action have been responded to fully. However, if, after consideration of the above amendments and comments, there remain any open issues in this application that possibly can be resolved by a telephone interview, then the Applicant's undersigned attorney most respectfully requests that he be called to discuss and attempt to resolve those issues.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "T. P. O'Connell", with a long horizontal line extending to the right.

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Date